

## **STATUS OF CLAIMS**

Claims 1-34 and 43-59 have been withdrawn, without prejudice, herein.

Claims 35-42 are pending.

Claims 35-42 stand rejected by the Examiner.

## **REMARKS**

Reconsideration of the present Application is respectfully requested.

### **Rejections based on 35 U.S.C. § 103 (a)**

Claims 35-39 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fokos et al (U.S. Patent No. 5,361,960) in view of DE 4028006 and Campbell, Jr. (U.S. Patent No. 5,024,128). Claims 40-42 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fokos, in view of DE 4028006 and Campbell, Jr., and in further view of Cox (U.S. Patent No. 6,612,570). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits the cited references, either separately or in combination, fail to either teach or suggest at least each of the limitations of Claim 35. First, the present Office Action only asserts that Fokos teaches “an unwind station 16 to an in feed system 30”, and apparently omits the fact that the unwind station must have variable braking tension, as recited in Claim 35. In fact, Fokos at col. 9, lines 25-33, which the present Office Action looks to in support of this feature, only teaches a secondary drive system including a second line shaft driven by the main shaft through a variable transmission. This transmission produces variations in the ratio of the speeds of the shafts. Therefore, this variable transmission not only ***does not form part of*** any unwind station, but also ***does not provide variable braking tensions***, as recited in Claim 35. Furthermore, Fokos actually teaches a splicer that feeds the rewound web from the roll to an infeed device having draw rolls that in turn feed the web to the rest of the line of finishing equipment, and that the infeed device sets the tension of the web (Fokos at col. 7, lines 45-50).

Second, the present Office Action omits the fact that the circumference of the diecutting cylinder is greater than the repeat length, as recited in Claim 35. This is because Fokos does not teach, or even suggest for that matter, a diecutting cylinder having a circumference greater than the repeat length.

Third, the present Office Action misinterprets Fokos in having a sensor for sensing the position of the die cutter, as recited in Claim 35 wherein “a second sensor for sensing the position of

the die cutting cylinder” is recited. Further, Applicant respectfully does not deem column 8, lines 46-65 (as cited in the present Office Action for support of this feature) as relevant to this particular matter, as this section of Fokos relates to gluing, drying and perforating, and makes no mention of sensors. However, the control system of Fokos is described at column 9, line 34 to column 12, line 10. As may be seen at column 9, lines 48-49, "the speed of each function cylinder is measure by an associated encoder 96." *Fokos*. Further Fokos teaches that "the processor counts the number of pulses produced by the associated encoder 96 during the interval T....[and applies a correction] to speed to slow the function cylinder." *Fokos Col. 10, lines 7-16*. Measuring speed as described in Fokos is different from the "sensing the position of the die cutting cylinder" as claimed within Claim 35. By measuring speed one cannot determine the position of something. Position and speed are related as speed is the first derivative of position. However, other than that relation, speed and position are independent quantities and measuring one is not the same as the sensing of the other.

Further, Applicant respectfully asserts that the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in the prior art and is instead based on Applicant’s disclosure. The present Office Action has rejected Claims 35 – 39 as being unpatentable over Fokos in view of DE 4028006, and Campbell, Jr. Applicant respectfully submits that Fokos is directed to off-line web finishing system with splice and missing mark stability. *See, Title*. DE4028006 is entitled (via rough translation) “Process for Compensating for Variations in Toolmaking Machines.” Campbell is directed to a “Sheeter for Web Feed Printing Press.” *Title*. The Present Office Action attempts to extract teachings of Fokos and combines teachings from DE4028006 for providing feedback which Fokos does not employ and Campbell for using cylinders with a circumference greater than the repeat length. While the German reference and Campbell do not teach other elements of the claimed invention to be in relevant arts. Further, Fokos does not employ feedback as the teaching of Fokos deem feedback unnecessary and Fokos does not employ

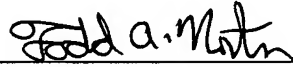
larger circumference cylinders because of the larger cumulative error created. *See Fokos generally and Col. 7.* Because of the deficiencies in Fokos the need arises in order to reject the present claims to combine the German reference and Campbell even though no other reason to combine is found in the prior art. Applicant thus respectfully submits that the skilled artisan would have found no motivation to combine the referenced teachings in the manner asserted, as the cited art itself provided neither a statement of such motivation, nor any evidence that such combination would have a reasonable likelihood of success. Applicant notes that the sole motivation provided appears to be that provided by the Examiner, not that provided in the prior art. **Applicant again respectfully requests that, should the Examiner persist in the assertion that such motivation and reasonable expectation of success exists, and if the Examiner thereby intends to take judicial notice of such motivation and expectation of success, that the Examiner provide some evidence in the prior art that such a motivation and reasonable expectation of success is present in the prior art.**

## CONCLUSION

Wherefore, Applicant believes that all outstanding grounds raised by the Examiner have been addressed and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

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